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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,550	04/15/2005	Alain Soyer	09669/060001	1417
22511	7590	10/30/2006	EXAMINER	
OSHA LIANG L.L.P. <sup>o</sup> 1221 MCKINNEY STREET SUITE 2800 HOUSTON, TX 77010				KOYAMA, KUMIKO C
		ART UNIT		PAPER NUMBER
		2876		

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/531,550	SOYER ET AL.
	Examiner Kumiko C. Koyama	Art Unit 2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 August 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1.8 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1.8 and 12-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 April 2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

Amendment received on August 02, 2006 has been acknowledged.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 8, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boccia et al (US 6,575,375) in view of Saito et al (US 4,754,319).

Re claims 1 and 8: Boccia discloses a panel 100 as shown in Fig. 6A, which a printed card, having a top surface and a bottom surface as shown in Fig. 6B. Fig. 1 and 4 show the customer logo personalization, and therefore teaches printing the printed card. The top surface having the micromodule 2 exposed is the first side and the bottom surface opposite to the top surface is a second side. The micromodules 2 are all aligned with each other as shown in Fig. 6A and the micromodules 2 are embedded in the panel 100 (col 4, lines 21-22). The micromodules 2 contain integrated circuits (col 3, lines 39-47). Strips or tongues 1 are cut, by means of a suitable tool (punch, laser or other), along with cutting lines 110 in order to obtain the shape depicted in the diagrams (Fig. 6A and col 4, lines 23-25). As shown in Fig. 6A, each strip or tongue 1 contains a micromodule 2. The strips or tongues teach at least two information supports are cut from the printed card and each of the two electronic information supports comprises one selected

from the group consisting of the first module and the second module. Boccia discloses that the integrated circuit 2 could be glued in a cavity formed at the support tongue.

Boccia fails to teach a first cavity and a second cavity and wherein the first cavity and the second cavity are aligned with each other. Boccia does not specifically teach that the integrated circuit is personalized.

Saito discloses sheets 36, 20 that are formed with two apertures 38, 22 large enough to receive the IC chips 26 (col 4, lines 5-10). As shown in Fig. 2, the apertures are aligned with each other. Such apertures are first and second cavities aligned with each other. Saito also discloses that the IC cards have recently been proposed which incorporate IC chip in place of the magnetic tape, where the magnetic tape stored various pieces of information, such as data for identifying the holder of the card (col 1, lines 15-20 and 25-28).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the teachings of Saito the teachings of Boccia and provide individual cavities for each micromodule because having cavities provides easy access and removal of the chip, and therefore, in case the chip needs to be replaced for any reason the cavity structure provides a faster access than the injecting technique.

Re claim 12: Fig. 6A and 6B shows that the support body 1 has a shape of a right parallelepiped. Boccia also discloses that the invention concerns a smart card type and corresponding to the international standards ISO 7816-1 and 7816-2 (col 1, lines 10-25).

Re claim 16: Boccia also discloses a cutting lines 110, which is a precut line on the first side and wherein the precut line distinguishes between a first of the at least two electronic

information supports and a second of the at least two electronic information supports as shown in Fig. 6A.

3. Claims 13-15, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boccia in view of Saito as applied to claim 1 above, and further in view of Laurila et al (US 6,591,116). The teachings of Boccia as modified by Saito have been discussed above.

Boccia discloses that a mini-SIM 3G (col 3, lines 50-56). Boccia also discloses a cutting lines 110, which is a precut line on the first side and wherein the precut line distinguishes between a first of the at least two electronic information supports and a second of the at least two electronic information supports as shown in Fig. 6A.

Boccia as modified by Saito fails to teach a that the SIM card is a 2G SIM card.

Laurila discloses a mobile equipment having 2G and/or 3G capabilities and a relationship to the SIM or USIM card that is in use (col 2, lines 60-65).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Laurila to the teachings of Boccia as modified by Saito and provide an additional 2G capabilities such that card can also be utilized in an older system such that the card holder can remain using the older system as well as the new system, and therefore, increasing the functionality as well as capability of the card and provides a wider usage.

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boccia in view of Saito as applied to claim 8 above, and further in view of Takeda et al (US 6,320,751). The teachings of Boccia as modified by Saito have been discussed above.

Boccia as modified by Saito fails to teach packaging each of the at least two electronic information supports with an associated insert for delivery to a customer.

Takeda discloses packaging and delivery step of the enveloping can be performed by the process of producing the IC card as it is (col 8, lines 50-55).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Takeda to the teachings of Boccia as modified by Saito in order to safely delivery the finished product to the customers, such that the customer can utilize the product as soon as it is ready to be used.

#### *Response to Arguments*

5. Applicant's arguments with respect to claims 1, 8 and 12-20 have been considered but are moot in view of the new ground(s) of rejection.

Applicant has amended the claims that added new limitation, such as "at least two electronic information supports are cut from the printed card and each of the at least two electronic information supports comprises one selected from the group consisting of the first module and the second module." Such new limitation necessitated new search and consideration. Therefore, arguments are moot in view of new grounds of rejection and subsequently, this action is Final.

#### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reignoux et al., U.S. patent No. 7,028,910, discloses a batch of n modules can be produced simultaneously on a plate on which areas are defined

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 571-272-2394. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Kumiko C. Koyama*  
Kumiko C. Koyama  
October 20, 2006

*[Signature]*  
MICHAEL G. LEE  
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